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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,717	06/01/2001	Tara J. Valentin	HANN-0001	1429
23550	7590	02/24/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			STEPHENS, JACQUELINE F	
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ALBANY, NY 12207			3761	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,717

Applicant(s)

VALENTIN ET AL.

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28,30-42 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28,30-42 and 56-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the elastic members of Yamaki are not located on a portion of Yamaki that extends above the front end (i.e., above the waist region). Nowhere does Yamaki teach that its elastic members are located on a portion of the garment that extends above the front portion) are not recited in the rejected claim(s). The back guard 32 of Yamaki extends above the front portion. The claim only requires the back guard comprises a separately positioned elastic, not that the elastic is on a portion that extends above a front portion. The separately positioned elastics 21 are located on the back guard 32, which meets the claim limitations. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues the back guard of Yamaki does not extend above a waist area or have opposing horizontal extension that extend laterally outward from outer edges of the vertical extension. With respect to the back guard extending above the rear portion, any part of the diaper leading away from the crotch region and towards the rear of the diaper is interpreted as the rear portion. The rear portion and front portions are defined in the claims relative to its position on the user. However, the size of a user may vary,

so the determination of a rear portion versus a vertical extension, a back guard, and its position comparative to the front portion is relative to the size of the user. Yamaki clearly shows horizontal extensions extending laterally from the back guard.

Applicant argues Hisada does not disclose opposing horizontal extensions that extend laterally outward from outer edges of the vertical extension. However, the limitation of outer edges of the vertical extension is broad and includes the top outer edge of the vertical extension. Taking this position, the sides 6 and 7 extend laterally from outer edge of the vertical extension.

Applicant further argues Hisada near teaches or suggests that the disposable undergarment in an incontinence article, that Glaug teaches a disposable incontinence article, and therefore, Hisada and Glaug are not in analogous art areas, do not have similar purposes, and do not solve similar problems. Hisada discloses the invention is used on an infant and the pants section may be replaced by conventional training pants (col. 5, lines 6 and lines 22-23). Furthermore, the invention has an absorbent portion, which one understands is for the absorption of body fluids, since the invention is a disposable absorbent underpant. Therefore, the inventions of Hisada and Glaug are analogous art in that they are used for the same purpose.

Claim Interpretation

2. The examiner interprets the term "incontinence article" to mean a multilayered composite structure that includes a liquid permeable body-side layer, a liquid impermeable outer cover, and an absorbent material positioned between the outer cover and the bodyside liner as disclosed in the specification page 1, lines 10-14. The examiner interprets the front and rear portion to mean a front portion for contacting a front side of a user and a rear portion for contacting a rear side of a user as disclosed in the specification page 7, lines 14-15. The examiner broadly interprets 'portion' to mean any part of the front or rear areas.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 22-24, 26, and 30-36, 40, and 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaki et al. USPN 5858012.

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As to claims 22, 23, 60, 62, and 63 , Yamaki discloses an incontinence article, comprising:

- a front portion (Figure 2);

- a rear portion (Figure 2) joined to the front portion; and

- a back guard 32 extending above the rear portion and the front portion when the article is worn by a user (Figure 1 and col. 2, lines 61-64). The back guard comprises an absorbent material 28 and a separately positioned elastic 21, 23 (Figure 2).

As to claim 24, the back guard 32 further comprises opposing side portions and a top portion (Figure 2).

As to claim 26, see Figure 2.

As to claims 30 , Yamaki discloses an incontinence article, comprising:

- a front portion (Figure 2);

- a rear portion (Figure 2) joined to the front portion; and

- a back guard 32 extending above the rear portion and the front portion when the article is worn by a user (Figure 1 and col. 2, lines 61-64). The back guard 32 comprises a vertical extension 32 and opposing horizontal extensions (Figure 2).

As to claims 31-35, the back guard comprises an absorbent material 28 and a separately positioned elastic 21, 23 (Figure 2).

As to claim 36, the absorbent has a t-shaped structure, with the larger width being in the back guard 32. Therefore, the back guard 32 has a width larger than any width in the absorbent in the rear portion (Figure 2).

As to claims 40 and 61, the limitation of 'extends to a middle back of a user' is directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. In this case, the standard is relative to the size of a user. For example, the article is capable of extending to a middle back of a small infant.

5. Claims 30, 37, 39, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hisada USPN 6482196.

As to claims 30 and 37, Hisada discloses an incontinence article, comprising: a front portion (Figure 1);

a rear portion (Figure 1) joined to the front portion; and
a back guard 3 extending above the rear portion and the front portion when the article is worn by a user, wherein the back guard comprises a vertical extension and opposing horizontal extensions (Figures 1 – 2C) where a portion of the center back guard constitutes a vertical extension and the sides of the back guard 3 constitutes opposing horizontal extensions.

As to claim 39, Hisada discloses the horizontal extensions laterally couple to the front portion (Figures 1 and 2A).

As to claim 40, the limitation of 'extends to a middle back of a user' is directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. In this case, the standard is relative to the size of a user. For example, the article is capable of extending to a middle back of a small infant.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al. USPN 5858012. Yamaki discloses the present invention substantially as claimed except Yamaki discloses the side portions and back guard is linear. It would have been an obvious matter of design choice to modify the side portions and back guard to be curved since applicant has not disclosed that the curved shape solves any state problem or is for any particular purpose and it appears that the invention of Yamaki would perform equally well with the linear portions since Yamaki

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teaches notches in the back guard to be smoothly curved along the wearer's waist (col. 3, lines 26-30).

9. Claims 28, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al. USPN 5858012. Yamaki does not disclose the vertical extension and horizontal extensions have a length of approximately 1.0 – 10.0 inches. Yamaki recognizes the length of the extensions should be sufficient to fit above the prominence of a wearer's belly and around a wearer's waist (col. 2, lines 24-32). It would have been an obvious matter of design choice to provide the article of Yamaki with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

10. Claims 38, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada USPN 6482196.

As to claim 38, Hisada discloses the present invention substantially as claimed except that Hisada discloses the horizontal extension couple linearly to the front portion instead of diagonally. It would have been an obvious matter of design choice to modify the horizontal extension to couple diagonally to the front since applicant has not disclosed that the curved shape solves any state problem or is for any particular purpose and it appears that the invention would perform equally well with the linear or diagonal coupling.

As to claims 41 and 42, Hisada does not disclose the vertical extension and horizontal extensions have a length of approximately 1.0 – 10.0 inches. Hisada recognizes the length of the extensions should be sufficient to fit above the prominence of a wearer's belly and around a wearer's waist (col. 2, lines 24-32). It would have been an obvious matter of design choice to provide the article of Hisada with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

11. Claims 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada USPN 6482196 in view of Glaug et al. USPN 5601545.

As to claims 56 and 57, Hisada discloses the present invention substantially as claimed. However, Hisada does not disclose the incontinence article guards have absorbent material. Glaug teaches an absorbent article with additional absorbent material in the waist areas for improved containment in the waist, particularly when a wearer is in a prostrate position (col. 1, lines 15-20 and 36-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the back and front guards of Hisada with absorbent material to provide improved containment 'as taught in Glaug, in the regions, which are protected by the front and back guards.

Hisada/Glaug discloses an incontinence article, comprising a front portion and front guard 2 (Hisada Figures 1 and 2A); and a rear portion and back guard 3 (Figures 1 and 2A) joined to the front portion. The limitations of 'extends ... to a middle back of a user' and 'extends... to a middle chest area of a user' are directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. In this case, the standard is relative to the size of a user. For example, the article is capable of extending to a middle back and middle chest of a small infant. The front and back guards of Hisada/Glaug comprise absorbent material (Glaug Abstract).

As to claim 58, Hisada/Glaug disclose elastics about the periphery of the front and rear guards (Hisada Figures 1-2C).

As to claim 59, Hisada/Glaug does not disclose the vertical extension and horizontal extensions have a length of approximately 1.0 – 10.0 inches. Hisada recognizes the length of the extensions should be sufficient to fit above the prominence of a wearer's belly and around a wearer's waist (col. 2, lines 24-32). It would have been an obvious matter of design choice to provide the article of Hisada with the claimed dimensions, since such a modification would have involved a mere change in the size of

a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

February 16, 2006